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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): Steinbichler et al.

Examiner: Lyons, Michael A.

Serial No.: 09/996,239

Group Art Unit: 2877

Filed: November 28, 2001

Docket: 298-147

For: PROCESS AND APPARATUS  
FOR RECORDING THE  
DEFORMATION...

Dated: September 16, 2003

**MAIL STOP AF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION TO WITHDRAW FINALITY OF OFFICE ACTION**

Sir:

In accordance with 37 C.F.R. §1.181, and M.P.E.P. §706.07(c) and 1002.02(c) it is respectfully petitioned finality of the Office Action mailed December 5, 2003 be withdrawn as premature, for the following reasons.

The art submitted in the timely-filed Information Disclosure Statement received August 23, 2002 was not made of record in the Office Action mailed April 16, 2003. After Applicants explicitly requested this art be made of record (in an Amendment filed September 22, 2003), the art was made of record and applied against the claims in the

Office Action mailed December 5, 2003.

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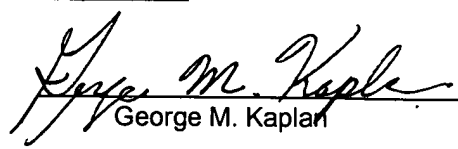
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**CERTIFICATE OF MAILING 37 C.F.R. § 1.8**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope, addressed to the Commissioner for Patents, MAIL STOP AF, P.O. Box 1450, Alexandria, VA, 22313-1450 on February 5, 2004.

February 5, 2004

  
George M. Kaplan



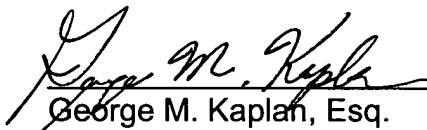
The Office Action mailed December 5, 2003 by the Patent and Trademark Office erroneously characterizes this art as having been submitted to the Patent and Trademark Office after mailing of the first Office Action; this is not the case. A Request for withdrawal of finality of the Office Action was submitted to the Patent and Trademark Office, by facsimile, on January 13, 2004; copies of all papers submitted including confirmation of receipt by the Patent and Trademark Office are enclosed. Thus far, the undersigned has not heard from the Examiner in charge of this application whether this Request has been considered. Accordingly, this Petition is being submitted within two months from the mailing date of the Office Action on December 5, 2003 to preserve all rights of Applicants.

It is respectfully pointed out Applicants are not challenging the right of the Examiner to apply this cited art in fashioning a rejection. Rather, Applicants are simply requesting any such application of this art, timely submitted to and received by the Patent and Trademark Office before issuance of the first Office Action but only made of record after issuance of the first Office Action upon explicit request by Applicants, be made in a nonfinal Office Action to allow Applicants full opportunity to consider the rejection and appropriately respond thereto.



For these reasons, it is respectfully requested finality of the Office Action mailed December 5, 2003 by the Patent and Trademark Office be withdrawn, with the response period reset to permit Applicants full opportunity to respond. A petition fee of \$130 in accordance with 37 C.F.R. 1.17(h) is enclosed. Please charge any deficiency or credit overpayment to Deposit Account No. 04-1121. Two copies of this sheet are enclosed.

Respectfully submitted,

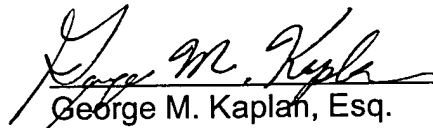
  
George M. Kaplan, Esq.  
Reg. No. 28,375  
Attorney for Applicant(s)

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For these reasons, it is respectfully requested finality of the Office Action mailed December 5, 2003 by the Patent and Trademark Office be withdrawn, with the response period reset to permit Applicants full opportunity to respond. A petition fee of \$130 in accordance with 37 C.F.R. 1.17(h) is enclosed. Please charge any deficiency or credit overpayment to Deposit Account No. 04-1121. Two copies of this sheet are enclosed.

Respectfully submitted,

  
George M. Kaplan, Esq.  
Reg. No. 28,375  
Attorney for Applicant(s)

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Examiner: Lyons, Michael A.

Serial No.: 09/996,239

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For: PROCESS AND APPARATUS  
FOR RECORDING THE  
DEFORMATION...

Dated: January 13, 2004

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION**

In accordance with M.P.E.P. §706.07(a), it is respectfully requested finality of the Office Action mailed December 5, 2003 by the Patent and Trademark Office be withdrawn, for the following reasons.

An Information Disclosure Statement was timely August 23, 2002, however the art cited therein was not made of record by the Patent and Trademark Office in the first Office Action mailed April 16, 2003. Accordingly, a copy of requisite Form PTO-1449 filed with the Information Disclosure Statement was included with the Amendment filed September 22, 2003.

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**CERTIFICATE OF FACSIMILE**

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office (1-703-872-9306) on the date shown below.

Dated: January 13, 2004

  
George M. Kaplan



The Office Action mailed December 5, 2003 states, in Conclusion on page 5 thereof.

Applicant's submission of an information disclosure statement under 37 CFR 1.97(e) with the fee set forth in 37 CFR 1.17(p) on September 22, 2003 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i) [underlining emphasis added]

However, this Information Disclosure Statement was not submitted September 22, 2003 with a fee, but rather filed August 23, 2002, well in advance of mailing of the first Office Action on April 16, 2003.

M.P.E.P. §706.07(a) reads, in pertinent part, as follows:

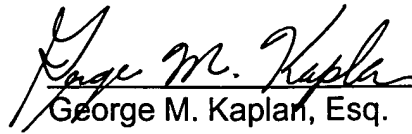
Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee, the Examiner may use the information submitted, . . . and make the next Office action final whether or not the claims have been amended . . . [emphasis added]

In the present instance, however, the art being applied against the claims was cited before issuance of the first Office Action, not thereafter and not with a fee. All previous grounds for rejection have been withdrawn in the Office Action mailed December 5, 2003, with the only grounds for rejection being a reference (U.S. Pat. No. 5,467,184 to Tenjimbayashi) cited in the Information Disclosure Statement filed August 23, 2002.



Accordingly, it is respectfully submitted finality of the Office Action mailed December 5, 2003 should be withdrawn as improper, to allow Applicants full opportunity to respond to the rejection raised therein on the merits with the response period also being appropriately reset to run from mailing of the non-final Office Action.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "George M. Kaplan", is written over a horizontal line.

George M. Kaplan, Esq.  
Reg. No. 28,375  
Attorney for Applicant(s)

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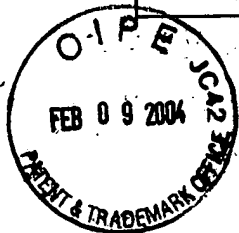


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**FACSIMILE TRANSMISSION****DATE: January 13, 2004****TO:****EXAMINER MICHAEL LYONS****FACSIMILE NO.:****1-703-872-9306****FROM:****George M. Kaplan, Esq.****PAGES:****4 (including this page)****YOUR REF:****Serial No. 09/996,239****OUR REF:****298-147****COMMENT:**

Enclosed, please find a **REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION**. Please confirm receipt of these documents by return facsimile. Thank you

Thank you.  
George M. Kaplan



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PAGES:	<u>4 (including this page)</u>			
YOUR REF:	<u>Serial No. 09/996,238</u>			
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